

REMARKS

At the time of the Fifth Office Action dated August 24, 2009, claims 6-9 and 16-17 were pending and rejected in this application. By this Amendment, claims 9 and 16-17 have been cancelled, and claims 18-20 have been added. Applicants respectfully submit that the present Amendment does not raise any new matter issue.

CLAIMS 6-9 AND 16-17 ARE REJECTED UNDER THE FIRST PARAGRAPH OF 35 U.S.C. §

112

Specifically, in the paragraph spanning pages 2 and 3 the Fifth Office Action, the Examiner the following:

The claim first positively receives a connection request from a cellular phone includes an identifier. The specification does not provide for a situation where there is an identifier provided from the gateway to the ecommerce server then the ecommerce system somehow having the identifier removed so that the final step of in response to determining that the connection request does not include the identifier, "executing session control by the electronic commerce server for the device using history information that is communicated between the system and the device" or in the case of claim 16 the connection request does not have the identifier i.e. "in response to determining that the connection request does not include the identifier." In this case the identifier cannot be determined but somehow it is stored in the very next step.

Independent claim 6 as amended distinguishes between the first connection request, which includes an identifier, and a second connection request, which does not include an identifier provided to the gateway. As such, Applicants have addressed the issues raised by the Examiner.

Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 6-8 under the first paragraph of 35 U.S.C. § 112.

CLAIMS 6-9 AND 16-17 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 3 and 4 of the Sixth Office Action, the Examiner asserted that the claimed invention, as recited in claims 6-9 and 16-17, fails to meet the requirements of 35 U.S.C. § 101.

Confusingly, on page 2 of the Sixth Office Action, the Examiner asserted that "Applicant's amendment and remarks were persuasive in overcoming the USC 101 and 103 rejections." Thus, on one hand, the Examiner has asserted that the rejection under 35 U.S.C. § 101 has been met, yet on the other hand, the Examiner has newly rejected the claims under 35 U.S.C. § 101. Applicants respectfully request that the Examiner clarify the record and indicate whether or not the claims are, in actuality, rejected under 35 U.S.C. § 101.

Notwithstanding the Examiner's ambiguous statements, the Examiner's comments that "the other portion of the claim which is critical to the novel functionality of the claim as argued by the application that includes the gateway does not provide for the use of a particular machine" are not appropriate. Claims are not required to enable the claimed invention (i.e., "provide for the use"). Enablement is covered under the first paragraph of 35 U.S.C. § 112, and applies to the specification, not the claims.

The test for determining whether or not a process claims meets the requirements of 35 U.S.C. § 101, was described by the Federal Circuit within In re Biliski¹ as follows:

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.

¹ Appeal No. 2007-1130.

There is no requirement that each and every element must be tied to a particular machine – only that the claim is tied to a particular machine. However, if the Examiner believes that Applicants' characterization of the case law is not correct, Applicants respectfully request that the Examiner supply case law that supports the Examiner's position.

For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-21 under 35 U.S.C. § 101.

On page 4 of the Fifth Office Action, the Examiner objected to claim 9 as being a substantial duplicate of claim 6. Since claim 9 has been cancelled, the Examiner's objection is now moot.

CLAIMS 6-9 AND 16-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SMETHERS, U.S. PATENT PUBLICATION NO. 2003/0055870 (HEREINAFTER SMETHERS), IN VIEW OF FOX ET AL., U.S. PATENT NO. 6,421,781 (HEREINAFTER FOX), AND APPLICANTS' ADMITTED PRIOR ART (HEREINAFTER THE ADMITTED PRIOR ART)

On pages 4-11 of the Fifth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Smethers, Fox, and the Admitted Prior Art. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination

Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on pages 5-7 of the Fifth Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. Applicants, therefore, request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines for Determining Obviousness, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have

known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Upon reviewing the Examiner's analysis in view of the requirements discussed above necessary for the Examiner to establish a prima facie case of obviousness, Applicants recognize deficiencies in the Examiner's analysis.

At the outset, Applicants note that the Examiner's characterization of Smthers fails to meet the requirements of 37 C.F.R. § 1.104(c).² Specifically, the Examiner has failed to designate, with specificity, where each of the claimed elements are alleged disclosed by Smthers. Instead, the Examiner's sole analysis is to state "Smthers teaches a server in contact with a wireless device and a PC (FIG 2).

As claimed, the gateway adds an identifier to the connection request. In this regard, reference is made to paragraph [0056] of Smthers, which states:

According to one embodiment of the present invention, a user desiring to obtain information from information server 280, places wireless client device 200 in the network mode of operation and presses and holds a pre-assigned key on the keypad of wireless client device 200. The software stored in client module 212 causes the key that was pressed and held to be recognized in a unique manner than that same key would be recognized in the telephone mode of operation. Specifically, instead of generating a alphanumeric character (e.g. "I"), a compact bookmark identifier is generated. Wireless client device 200 establishes a connection with proxy server device 254 via airnet 250 and transmits a compact request for the document identified by the compact bookmark identifier. The compact bookmark identifier is used to access previously stored bookmark information on proxy server device 254. Using the stored bookmark information, proxy server device 254 generates a normal request for the document originally identified by the compact bookmark identifier. The normal request is then forwarded over landnet 260 to information server 280 (where the requested documents resides). One of ordinary skill in the art will appreciate that if wireless client device 200 is in a non-network mode (e.g., telephone mode) of operation then software within wireless client device 200 can cause wireless client device 200 to be placed in the network mode of operation upon detecting that a pre-assigned key has been press and held so as to select a previously assigned bookmark.

Based upon the teachings found therein, the client module 212 creates the compact bookmark identifier and that is sent to the proxy server device 254. Using the compact bookmark identifier, the proxy server device 254 generates a normal request for the document identified by the compact bookmark identifier. These teachings are not consistent with the claimed language which states that the gateway adds the identifier to the connection request, and the identifier

² 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

corresponds to an identification code of the mobile phone. Thus, the Examiner has mischaracterized the scope and content of Smethers.

Applicants are also unclear as to where Smethers teaches the claimed electronic commerce server. Smethers refer to an information servers 124 and 280. However, are unclear as to what constitutes the claimed electronic commerce server. Thus, the Examiner has further mischaracterized the scope and content of Smethers.

In the paragraph spanning pages 5 and 6 of the Fifth Office Action, the Examiner asserted the following:

((It would have been obvious to a person having ordinary skill in the art [at] the time of the invention to include using a different mechanism to effect session control when a request was not from a proxy that has sent a request with a device identifier, because this will allow a single server to process multiple request thus decreasing the cost of providing a separate server) not part of the BPAI response).

As is readily apparent from the above-reproduced language, the Examiner has disposed of several claim limitations with nothing more than a conclusory statement that has no basis in fact. As stated by the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In the present instance, the Examiner pulls both the problem to be solved and the solution to the problem out of thin air. Moreover, the Examiner has failed to identify any teaching with the applied prior art of adding, by a gateway, an identification code to a connection request from

1 a mobile phone and then forwarding the connection request (with the identification code) to an
2 electronic commerce server.

3
4 The Examiner's reliance upon column 10, lines 40-47 of Fox is also misplaced. Although
5 this particular cited passages refers to an identifier within a request, this identifier does not refer
6 to the identification code of the mobile phone or otherwise identify a particular device. Instead,
7 as taught by Fox, the "identifier is used to identify the notification for future reference." As
8 such, these teachings are not relevant to the limitations at issue.

9
10 For the above-described reasons, the Examiner has failed to establish that the claimed
11 invention, as recited in claims 6-8, would have been obvious within the meaning of 35 U.S.C. §
12 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 6-8
13 under 35 U.S.C. § 103 for obviousness based upon Smethers in view of Fox and the Admitted Prior
14 Art.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 24, 2009

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320